No. 815

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IN THE

Supreme Court of the United States

OCTOBER TERM 1943

PHILIP ZALKIND,

Petitioner,

v.

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION, MASELL MANUFACTURING CORPORATION,

Respondents,

and

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION,

Respondents,

v.

GUIDE SYSTEM & SUPPLY CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable, The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Philip Zalkind, prays that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit rendered December 10, 1943, affirming judgment of the District Court for the Southern District of New York rendered February 25, 1943. That judgment dismissed a portion of petitioner's claim for relief on the merits and before trial.

I

Jurisdiction

Jurisdiction is based on Section 240(a) of the Judicial Code as amended; 28 U. S. Code 347.

The order for mandate of the Circuit Court of Appeals was entered December 29, 1943 (Rec. p. 116).

II

Opinions Below

The District Court dismissed that portion of the complaint which alleged misuse of Patent Office interference proceedings to delay issue of plaintiff's patent and which sought damages for the period of such delay (Rec. p. 76) in a decision reported at 57 U. S. P. Q. 104 and not officially reported. This decision was based on a prior decision of the same court (Rec. p. 67) reported at 49 Fed. (Supp.) 753. The opinion of the Circuit Court of Appeals affirming the decision of the District Court is reported at 139 Fed. (2) 895 (Rec. p. 91).

III

Summary Statement of Matter Involved

This is a petition for a writ of certiorari to review the dismissal before trial for lack of jurisdiction of a portion of the claim for relief in a suit in equity for an injunction and accounting under U. S. Letters Patent No. 2,118,011, 2,233,906 and 2,245,026.

There is no diversity of citizenship.

The amended complaint charges infringement and a course of conduct on the part of the defendants based on

misuse of interference proceedings to delay the issue of plaintiff's patents for years (Rec. p. 72); and asks for damages from the time plaintiff's patents would have issued but for the delay wrongfully caused by defendants and for three-fold damages (Rec. p. 73).

Petitioner asserts that he is entitled to demonstrate at the trial that he can prove the entire cause of action, including both claims for relief, with only the facts necessary to establish the patent infringement claim.

The Circuit Court of Appeals for the Second Circuit (with a minority dissent) has assumed without any warrant in the record or pleadings before it and entirely on supposition that the character of defendant's wrongful acts in misusing interference proceedings to delay issue of plaintiff's patents must necessarily require proof beyond the record in the interference (Rec. p. 104).

On the basis of this unsupported assumption, the Court below dismissed that portion of the complaint alleging misuse of interference proceedings to delay issue of plaintiff's patents and seeking damages for the period of such delay.

This decision was based entirely on the case of *Hurn* v. *Oursler*, 289 U. S. 238.

Assuming for this appeal that a cause for damages for wrongful misuse of interference proceedings, in the absence of diversity, is not a Federal matter,—

IV

The Questions Presented Are:

1. Where a plaintiff brings a patent infringement action and joins therewith a claim for damages for wrongful misuse of interference proceedings, may a Court dismiss the additional non-federal claim before trial on the pleadings only and on the basis of a supposition that the proof will go beyond the federal claim?

2. Can the Court in such a case make an assumption before trial that the proof for the two claims will not be substantially identical?

3. Must the plaintiff in such a case, to avoid such an assumption, allege in his complaint evidentiary matter to negative that assumption?

4. May these claims in such case be joined where only the evidence admissible on the patent infringement claim (which included the interference record) is relied on to prove the claim for wrongful misuse of interference proceedings?

5. Where the jurisdiction of the Court depends on the evidentiary facts, may the Court dismiss for lack of jurisdiction before trial?

And, finally:

6. Is a claim for relief for fraudulent utilization of interference proceedings to delay the issue of an inventor's patent so that a wrongdoer may without consent of the inventor, after the filing of the inventor's application, make use of the invention for an extended period of time constitute a claim within the purview of jurisdiction of the Federal Courts in view of: Title 28, U. S. Code, Section 41, subsection 7; Title 28, U. S. Code, Section 371, subsection 5; Title 35, U. S. Code, Section 52; and Title 35, U. S. Code, Section 48?

V

Reasons for Granting the Writ

The jurisdictional question involved requires an interpretation of the doctrine of the *Hurn* v. *Oursler* case, 289 U. S. 238, with respect to which there have been many divergent and unreconcilable decisions in the various circuits.

Various decisions in the various circuits, applying the rationale of the opinion in the *Hurn* v. *Oursler* case, have reached conflicting views: Some Courts have applied the rule liberally allowing any substantially interwoven federal and non-federal claims to be tried together (*E. Edelmann & Co.* v. *Triple-A Specialty Co.*, 88 F. [2] 852, C. C. A. 7; *Hemmeter Cigar Co.* v. *Congress Cigar Co., Inc.*, 118 F. [2] 64, C. C. A. 6; *Atkins* v. *Gordon*, 86 F. [2] 595, C. C. A. 7). The Second Circuit has applied the rule of *Hurn* v. *Oursler* to distinguish the chief holding thereof on only slightly dissimilar facts. Thus, for instance, in a discussion of the effect of the rule of *Hurn* v. *Oursler* in volume 52 of the Yale Law Journal at page 922, a statement is made at page 924:

> "Not only is there disharmony among the rulings of the several circuits on this same issue, but rulings by different judges in the same circuit are sometimes not in strict rapport. Particularly difficult to reconcile are the decisions of the Second Circuit" (*Treasure Imports* v. *Amdur*, 127 F. [2] 3; *Musher Foundation* v. *Alba Trading Co.*, 127 F. [2] 9, cert. den. 317 U. S. 641; *Pure Oil Co.* v. *Puritan Oil Co.*, 127 F. [2] 6).

Moore's Federal Practice, Volume 1, in the 1942 supplement, at page 83 states:

> "The Second Circuit rule—In Lewis v. Vendome Bags (C. C. A. 2d, 1939), 108 F. (2) 16, cert. den. (1940) 309 U. S. 660, 60 S. Ct. 514, 84 L. Ed. 1008, the Second Circuit purports to follow Hurn v. Oursler, but its decision is based on a very restrictive concept of cause of action for jurisdictional purposes. It is proper to make the same criticism of Musher Foundation v. Alba Trading Co. (C. C. A. 2d, 1942, 127 F. [2] 9, cert. den. 1942, U. S. , 63 S. Ct. 33, 87 L. Ed.)"

In all of the cases that have been decided pursuant to the rule of *Hurn* v. *Oursler*, the Appellate Court had an opportunity to study the entire question of jurisdiction with relation to the facts and the evidence as brought out at

a trial. Thus, the Appellate Court was fully equipped to determine whether or not the jurisdictional facts of the claims for relief involved fell within the *Hurn* v. *Oursler* doctrine.

This is the first case brought to this Court where an attempt has been made to apply the *Hurn* v. *Oursler* doctrine before trial in the absence of such facts as might be brought out by the evidence to assist in a determination of jurisdiction.

Apart from the prime necessity for so emphasizing or restating the *Hurn* v. *Oursler* doctrine that it will be applied uniformly in all jurisdictions, the following additional important and novel question is presented by this appeal: May a Court in following the *Hurn* v. *Oursler* doctrine, to determine whether or not jurisdiction of the non-federal claim for relief may be retained, make a determination with respect to jurisdiction under that doctrine before trial and in the absence of any evidence on the basis of which it may determine that the jurisdictional facts fall within or entirely outside of the *Hurn* v. *Oursler* doctrine?

The determination of this question, in addition to considerations of uniformity in the various jurisdictions, render the present issue of national importance, for if such a determination may be reached before trial, the rule of the *Hurn* v. *Oursler* case is nullified.

Wherefore petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court directed to the Circuit Court of Appeals for the Second Circuit commanding that Court to certify and to send to this Court for its review and determination on a day certain to be named therein a full and complete transcript of the record and of the proceedings in the case numbered and entitled on its dockets "No. 94 October Term, 1943, Philip Zalkind, Plaintiff-Appellant, against Sol Scheinman, Jacob Mandel, Pronto File Corporation, Masell Manufacturing Corporation, Defendants-Appellees, and Sol Scheinman, Jacob Mandel, Pronto File Corporation,

Third Party Plaintiffs, against Guide System & Supply Co., Inc., Third Party Defendant", and that the decision of the said Circuit Court of Appeals in said case and of the District Court be reversed and the additional claim for relief be reinstated, and that your petitioner have such other and further relief as in the premises may be just.

PHILIP ZALKIND,
Petitioner.
By SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.

Certificate

We hereby certify that we have examined the foregoing petition, that in our opinion it is well founded and entitled to the favorable consideration of the court, and that it is not filed for the purpose of delay.

SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

I

The decision of the Second Circuit Court of Appeals in this case is in conflict with decisions in other circuit courts.

The conflict, not only among the decisions of the Circuit Court of Appeals for the Second Circuit, but between the decisions of that court with the decisions of courts of other circuits, has already been referred to in the petition. The decisions of this Court are in conflict with at least those of the sixth and seventh circuits.

Thus, in *E. Edelmann and Company* v. *Triple-A Specialty Co.*, 88 Fed. (2) 852, decided February 17, 1937, the Circuit Court of Appeals for the Seventh Circuit was presented with an action for declaratory judgment to determine the validity of a patent. There was no diversity of citizenship. There was joined with the action for declaratory judgment a charge of unfair competition for circulation of wrongful charges of infringement. The defendant contended that since there was no diversity, there was no jurisdiction with respect to the charge of unfair competition. The Court, however, retained jurisdiction of the charge of unfair competition and stated at page 854:

> "Appellant urges, however, that the prayer for damages because of circulation of charges of infringement among dealers and potential customers, stamps appellee's suit as one to enforce a common law remedy, namely: recovery of damages for unfair competition. If this were the only end sought and the jurisdiction of the court invoked to secure only that relief, the contention would necessarily prevail. But appellant relies upon two remedies, first, the determination of whether the patent is valid and infringed, and second, if either of these questions is answered in the negative,

> whether it is also entitled to damages for violation of its common law rights arising out of the same facts, plus the additional fact that appellant has wrongfully circulated among the trade, false charges of infringement. The relief sought upon the second branch is upon a footing entirely apart from that prayed upon the first. Appellee included as a basis for one sort of relief, facts pertinent only under the patent laws of the United States, over cases arising under which the federal courts have exclusive jurisdiction. It included also a prayer for another sort of relief of which any state court might have jurisdiction, and which, the federal court in the absence of other basis for jurisdiction, might not entertain except in case of diversity of citizenship."

The Court, after having taken note of the fact that the charge for violation of common law rights arose out of the same facts "plus the additional fact that appellant has wrongfully circulated among the trade, false charges of infringement", applied the *Hurn* v. *Oursler* case to the facts before it and ruled as follows:

> "Under Hurn v. Oursler, 289 U. S. 238, the court was endowed with jurisdiction also to determine the issues as to fair competition."

Thus, this decision of the Seventh Circuit is in direct conflict with the decision in the present case (see pages 10 and 11 of this brief) and with the view generally held by the Second Circuit Court of Appeals.

In *Atkins* v. *Gordon*, 86 Fed. (2) 595, decided by the Seventh Circuit Court of Appeals, November 30, 1936, there again was no diversity of citizenship. A cause of action for infringement was joined with a cause of action for damages for the use of unfair trade methods. Although the Court in that case held against the plaintiff, it refused jurisdiction of the unfair trade methods charge solely on the basis of the invalidity of the patent and stated definitely in the last paragraph of the decision that with respect to the charge of the use of unfair trade methods,

> "the Federal court's jurisdiction is dependent upon appellee's sustaining the patent infringement charge of the complaint."

Here again the view of the Seventh Circuit Court of Appeals in contrary to that of the Second Circuit.

In *Hemmeter Cigar Co.* v. *Congress Cigar Company, Inc.,* 118 Fed. (2) 64, decided March 14, 1941, in the Circuit Court of Appeals for the Sixth Circuit, the Circuit Court of Appeals in that circuit, in an action for trade-mark infringement, retained jurisdiction to decide on the merits the right of the plaintiff to recover for intrastate sales of articles bearing the plaintiff's trade mark. The Court here again applied the doctrine of *Hurn* v. *Oursler* and stated at page 68:

> "Appellee submits that because the distribution of 'Portina Champs' was exclusively intrastate, appellant has no cause of action for trade mark infringement. The question seems academic, for the reason that in Hurn v. Oursler, 289 U. S. 238 (17 U. S. P. Q. 195), where a claim of copyright infringement was embraced in the same bill with a claim for unfair competition under state law, both claims being based on the same acts, the Supreme Court held that, although the federal copyright claim must be rejected on its merits, the federal court still had jurisdiction to decide the unfair competition claim on its merits, because a federal question had been raised on the pleadings.
>
> The same situation is found here."

The Court retained jurisdiction.

Thus in the *Edelmann* case the Court found that even where additional facts were needed for the non-federal claim, jurisdiction may be retained; whereas in the present case the Court, merely because it supposes that additional facts may be necessary, denies jurisdiction.

Both cases support their respective positions by the *Hurn* v. *Oursler* case.

In the *Atkins* case the Court made jurisdiction of the non-federal claim dependent on the success of the federal

claim, thus disagreeing with the present case and even with the *Edelmann* and *Hemmeter* cases.

In the *Hemmeter* case the Court retained jurisdiction of the claim involving intrastate sales, even though the federal claim could involve only interstate sales, disagreeing both with the view of the *Atkins* case and with that of the present case.

Thus the foregoing cases show that there is direct conflict among the decisions in the various circuits and that it is of importance that the conflict be resolved.

II

A dismissal of the apparently non-federal claim for relief (joined with a federal claim) before trial on the basis of mere supposition as to the proof required therefor deprives the Court of even the right to determine whether it has jurisdiction of the claim.

The majority decision of the Court of Appeals for the Second Circuit, in discussing the petitioner's claim for relief for defendants' (respondents) fraudulent misuse of interference proceedings, states (Rec. pp. 103-104):

> "So here, disregarding the time factor as such, we find it impossible to hold that the 'substantially identical proof' test can yield federal jurisdiction here, in the light of the denial of such jurisdiction as to the third claim in the Oursler case. A much closer relationship was present there between the facts supporting (a) the first claim for violation of the copyright and (b) the third claim for wrongful acts as to the uncopyrighted version than is present here between the facts necessary to support (a) the claim for infringement of the patent and (b) that for the defendant's alleged misconduct in delaying the issuance of the patents. This, indeed, is an a fortiori case. For, while proof of some parts of the Patent Office history might conceivably be pertinent, in some circumstances, in the trial of the patent infringement, such proof would not

> by any means cover the bulk of the evidence which the plaintiff would be obliged to introduce in order to show the alleged misconduct of the defendant during the pendency of the patent application in the Patent Office."

This, of course, is supposition on the part of the Court. The Court below, continuing, concedes that (Rec. p. 104):

> "It may perhaps be true that, to sustain his second as well as his first claim, plaintiff here would be required to prove the validity of his patent and, for that purpose, to introduce evidence of novelty as against the prior art."

The Court then asserts (Rec. p. 104) entirely on supposition:

> "But to sustain his second (non-federal claim) (fol. 109) he would need, as his pleadings demonstrate, to go far beyond that and to make proof of many substantial additional facts not relevant to the first claim."

Finally, the Court below gives some examples of the kind of "additional" facts it supposes will require additional proof not part of the claim for infringement (Rec. p. 104):

> "He would need to prove that the defendants had filed patent applications based on their false oaths; that plaintiff had previously disclosed his inventions to them and they had previously seen and tested the commercial embodiments of his inventions; and that in interference proceedings with plaintiff they had testified falsely and induced false testimony to be given."

It has frequently been held that the interference record is admissible in an infringement record on the issue of patentability (see, for example, *Warren Telechron Company* v. *Waltham Watch Company* [C. C. A. 1], 91 F. [2] 472).

Petitioner asserts that the interference record which is thus admissible proves all of the facts which the Court below suggests that petitioner must prove to sustain the claim for misuse of interference proceedings—and more,

the interference record is the only evidence that need be relied on to prove the entire claim.

In the face of this assertion, which for purpose of this argument can be taken as a supposition by a party familiar with the facts and willing to be bound by the assertion, can we fairly rely on a supposition of a Court which does not have testimony before it and thus cannot be familiar with the facts?

Having adopted this restrictive point of view based entirely on supposition as to what the evidence will be, it cites *Hurn* v. *Oursler* as authority and states (Rec. p. 104):

> "From the point of view of convenience to plaintiffs and 'judicial economy,' there is indeed much to be said in favor of the proposal generously to extend the Oursler doctrine. But this court cannot indulge in such generosity until the Supreme Court authorizes us to do so."

In the *Hurn* v. *Oursler* case there was no need to guess or suppose what the facts would be, nor does there seem to be authority in that case for such a guess or supposition before trial.

When the issue of whether facts to prove one claim are the same as or include the facts to prove the other claim is the issue on which jurisdiction is based, can jurisdiction be denied on supposition alone?

Does not this vitiate the *Hurn* v. *Oursler* rule?

How can the Court even determine whether or not it has jurisdiction when its jurisdiction is based on facts which it will not hear?

III

The appropriate application of the *Hurn* v. *Oursler* rule requires that the action be permitted to reach trial on both claims; with judicial economy and a due regard for the limits of federal jurisdiction being maintained by a refusal to admit any testimony which does not tend toward establishing the purely federal claim.

Since the issue of jurisdiction is thus one of fact, fairness to all parties and true judicial economy is achieved by permitting the case to go to trial in such a manner that plaintiff may, if he is entitled to it jurisdictionally and on the merits, obtain full relief and so that defendant need not be harassed unnecessarily by preparation for matter which does not bear on the purely federal question.

The trial court is competent during the trial to exclude evidence which does not tend to prove the purely federal claim. At the conclusion of the case, three alternative decisions are possible, as in any case:

A. If none of the evidence at all which has been received in support of the federal claim supports the non-federal claim, then the court should dismiss for lack of jurisdiction.

B. If the evidence which proves the federal claim *tends* toward proving the non-federal claim but does not fully prove the latter claim, then the court may dismiss on the merits.

C. If, of course, the evidence received on the federal claim does prove the non-federal claim, then the court may grant complete relief without burdening the defendant unnecessarily or removing from the state court any of its prerogatives.

The defendant is fully protected:

If no evidence is offered at any trial with respect to a claim for relief, the dismissal of that claim is almost invariably not on the merits (equivalent to alternative A above).

If the evidence received on the federal claim tends to prove the apparently non-federal claim but does not fully do so, the dismissal on the merits (alternative B above) protects defendant for this claim is then res adjudicata.

However, if the evidence received on the purely federal claim establishes the apparently non-federal claim, then the *Hurn* v. *Oursler* doctrine is applicable, jurisdiction is complete, full relief is obtained in a single action and judicial economy is served.

IV

The Federal Court has jurisdiction since the apparently non-federal claim in this case is clearly ancillary to the federal claim and capable of proof by the very proof which tends toward establishing the federal claim.

The character of proof which is necessary to establish the apparently non-federal claim and the fact that it is the same proof which will establish the purely federal claim has already been discussed.

The decisions of this Court in *Hurn* v. *Oursler*, as well as in *Osborn* v. *U. S. Bank*, 9 Wheat. 738, 823 (referred to on page 15 of this brief), show that the Federal Court takes jurisdiction on two grounds:

1. Under the statute.

2. Under a long recognized right of the Court to hear and decide even non-federal matters ancillary to the statutory issue in order to arrive at a just final decision between the parties, this practice going so far as to allow the defendant to set up any counterclaim whether arising out

of the subject matter of the statutory issue or not, in order to arrive at a just final settlement of any and all controversies between plaintiff and defendant.

This is a recognition that the Court once empowered to act on a statutory matter cannot be tied down to making an unjust or incomplete decision by a failure to give it statutory authority to hear and consider other non-statutory matters which would alter the unjust decision and enable the Court to do final justice between the parties.

It seems that the Second Circuit is putting too limited a definition on what is a non-federal issue ancillary to the main issue. The opinions of the Second Circuit seem to indicate that the non-federal issue can be ancillary to the statutory issue not alone by the fact that it is established wholly by the testimony directed at the statutory issue, but also that it must be spelled out directly from the allegations that only such testimony can be used.

This seems too narrow a distinction if the theory of "judicial economy" amounts to anything. It disregards the aim of reaching a final just decision of all issues between the parties, recognized by allowing a defendant to counterclaim on any issue, whether statutory or non-federal or whatever it may be.

We have examined all the cases we could find dealing with a federal court's jurisdiction of a non-federal claim joined with a federal claim. In every instance the issue was decided on whether all the facts as established at the trial in support of the non-federal claim were substantially the same as those used in proving the federal claim.

Starting with *Hurn* v. *Oursler*, 289 U. S. 238, and all the cases therein cited, it appears that this measure of facts as established at a trial was the criterion in determining jurisdiction of the non-federal claim.

All of these determinations could properly have been made only because a trial had been had.

There is no constitutional restriction on this view; thus, in the *Hurn* v. *Oursler* case this Court said at page 238:

> "As early as Osborn v. U. S. Bank, 9 Wheat. 738, 823, Chief Justice Marshall, speaking for the Court, said:
>
> 'We think, then, that when a question to which the judicial power of the Union is extended by the constitution, forms an ingredient of the original cause, it is in the power of Congress to give the Circuit Courts jurisdiction of that cause, although other questions of fact or of law may be involved in it.'"

Here, Judge Marshall admitted even "other questions of fact".

Nor is there any statutory restriction on this view. Thus this Court, in order to facilitate the administration of justice and the complete determination of all issues between parties, has in the "Rules of Civil Procedure" (Rule 13) set forth criteria for the introduction of counterclaims which do not require that the counterclaim raise a federal question (especially Rule 13b); and jurisdiction of the non-federal counterclaim remains even though the complaint on the federal question is dismissed (see, for instance, *Moore* v. *N. Y. Cotton Exchange*, 270 U. S. 593, 607-610, decided even before the present more liberal Rules of Civil Procedure were promulgated).

V

Federal jurisdiction in this case is consistent with statute, the *Hurn* v. *Oursler* doctrine, and does not diminish or intrude upon the realm of jurisdiction of the state courts.

It is urged here that jurisdiction be taken entirely within the doctrine of *Hurn* v. *Oursler:* that the proof offered to establish the apparently non-federal claim be limited only

to proof tending to establish the purely federal claim. With this limitation, no invasion of the area of State Court jurisdiction is contemplated since no additional facts outside those which tend to establish the federal claim can be received.

VI

Statutes Involved.

Sec. 24—Judicial Code (Title 28, U. S. C., Sec. 41):

> The district court shall have original jurisdiction as follows:
>
> * * * * * * *
>
> Seventh: Of all suits at law or in equity arising under the patent, the copyright and the trade-mark laws.

Sec. 256—Judicial Code (Title 28, U. S. C., Sec. 371):

> The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States:
>
> * * * * * * *
>
> Fifth: Of all cases arising under the patent-right, or copyright laws of the United States.

Sec. 4904—Revised Statutes (Title 35, U. S. C., Sec. 52):

> Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, within such time, not less than twenty days, as the commissioner shall prescribe.

Sec. 4899—Revised Statutes (Title 35, U. S. C., Sec. 48):

> Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

VII

Conclusion

It is respectfully submitted that the writ of certiorari prayed for be granted and that the decision of the Circuit Court of Appeals and of the District Court be reversed with costs.

Respectfully submitted,

SAMUEL OSTROLENK,
Solicitor for Petitioner.

SIDNEY G. FABER,
MITFORD C. MASSIE,
of Counsel.

No. 815 (31)

APR 24 1944
CHARLES ELMORE CROPLEY
CLERK

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Supreme Court of the United States

October Term, 1943.

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AND

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION,

Respondents,

v.

GUIDE SYSTEM & SUPPLY CO., INC.,

Third Party Defendant.

BRIEF FOR RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

PHILIP ZALKIND,

Petitioner,

v.

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION and MASELL MANUFACTURING CORPORATION,

Respondents,

AND

SOL SCHEINMAN, JACOB MANDEL, PRONTO FILE CORPORATION,

Respondents,

v.

GUIDE SYSTEM & SUPPLY CO., INC.,

Third Party Defendant.

Brief for Respondents Opposing Petition for Writ of Certiorari.

Petitioner seeks to have this Court review its own decision in *Hurn* v. *Oursler,* 289 U. S. 238 on the alleged ground that it has been variously interpreted in different circuits. In effect, the petition seeks to have this Court reverse its position in denying certiorari in, among others, *Musher Foundation* v. *Alba Trading Co.,* C. C. A. 2, 127 F. (2) 9, cert. den. 317 U. S. 641; 63 Sup. Ct. 33, discussed more fully hereinafter, and in

Lewis v. *Vendome Bags* (C. C. A. 2, 1939) 108 F. (2) 16; cert. den. (1940), 309 U. S. 660; 60 Sup. Ct. 514.

The original Complaint set forth two separate causes of action (R. 4, 6) one for patent infringement and the other a common law action based on alleged fraudulent acts said to have been committed prior to the issuance of the patents and allegedly designed to delay the issuance of the patents. The prayer for relief demanded "with respect to the first cause of action", an injunction and "an accounting for profits and damages", etc.; and "with respect to the second cause of action judgment in the aggregate amount of $110,000" (R. 13).

There being no diversity, defendants moved for dismissal of the second cause of action (R. 66). The District Court, by Judge Bondy, granted the motion (R. 67). Within twenty days of the entry of Judge Bondy's order, plaintiff elected to file an amended complaint (R. 70), *limiting the action* to "a suit brought for infringement of United States Letters Patent" (R. 71, Par. 1). The prayer for relief (R. 73) demanded an injunction and "an accounting for profits and damages *for infringement* from the time that they [the patents] would have issued but for defendants' wrongful perversion of the Patent Statutes". No relief for any common law tort was prayed for.

Petitioner thus elected to abandon his alleged claim for fraud and to restrict the action solely to patent infringement. However, the charge of infringement in the amended complaint was interlarded with charges of conspiracy to delay the issuance of plaintiff's patents and of presenting false testimony in a Patent Office interference. Defendants moved to strike such irrelevant portions of the amended complaint and the motion was granted by Judge Caffey (R. 76). Petitioner appealed both orders (R. 80). Following denial, "with leave to renew" (R. 90), of respondents' motion to dismiss the

appeal, and after argument on the merits, the Circuit Court of Appeals dismissed the appeal from Judge Bondy's order and affirmed Judge Caffey's order (R. 109).

POINT I.

The petitioner raises only moot questions because only one cause of action is alleged in the amended complaint.

The petition seeks to make it appear that this patent infringement action involves at the same time "a cause for damages for wrongful misuse of interference proceedings" (p. 3).

No such thing appears from the amended complaint (R. 70). This declares only in infringement (R. 71) and seeks an accounting for profits and damages only for infringement (R. 73), albeit from an imaginary date (when the patents "would have issued"). Petitioner proceeds to argue as if the amended complaint actually sought relief on each of two causes of action, when in point of fact only one cause is declared and relief is demanded only for such one cause.

This meaning of the amended complaint is consistent with petitioner's compliance with Judge Bondy's order dismissing the second cause of action (for fraud). If petitioner intended to contest this order he should have stood on his original complaint. Instead, he accepted the leave to amend and file his amended complaint within twenty days. Petitioner is now asking this Court to undo what he voluntarily did in filing his amended complaint.

We are not alone in this interpretation of the amended complaint. It is petitioner's own interpretation. In fact, he has urged below that he deliberately limited his suit to one cause of action. As pointed out by Judge Caffey (R. 76):

> "Indeed, in his brief, page 1, the plaintiff expressly says that the 'present complaint [second amended complaint] presents a single cause of action which on its face charges solely patent infringement'."

On the record, therefore, petitioner has admitted that his suit involves only a claim for statutory infringement, and not also a common law cause of action for fraud and conspiracy. Hence *Hurn* v. *Oursler* is not pertinent and no review of such case seems to be necessary or can be of any avail to petitioner.

It is the rule that a party may not both accept a decision and reject it. Once he has made his election he is bound thereby.

The law is believed to be well stated in the following:

> "The general rule is that where a party, after an order sustaining a demurrer to his pleading, by leave of Court, files an amended pleading, he is deemed to have acquiesced in the action of the court upon the demurrer, and will not be permitted to appeal or assign such action as error in the appellate court. However, the mere fact that the court on sustaining a demurrer, and without any request therefor, grants leave to amend does not bar an appeal if the party against whom the demurrer is sustained does not act on such leave, but elects to stand on his pleading."—2 American Jurisprudence, pp. 972, 973.

To the same effect is *Corpus Juris Secundum* Vol. 4, p. 399.

Only one cause of action, therefore, is involved here.

In view of the foregoing, we submit that the writ should be denied.

We present the following on the assumption that the Court may wish to consider the petition also on the basis of the alleged two causes of action in the light of *Hurn* v. *Oursler*.

POINT II.

Petitioner has had his day in court, for courts below necessarily assumed that all allegations in the complaint were true for the purposes of defendants' motions.

In demanding a trial to determine whether the same facts will support both his claims, petitioner has overlooked that in reaching their decisions on defendants' motions to dismiss, the District Court judges and the Court of Appeals necessarily assumed for the purposes of the motions that petitioner could prove all charges made in his complaint. He could not have obtained a more favorable background for a decision if the case had gone to trial.

Since petitioner urges as the main, if not the only, ground for granting the writ that the lower courts should have given him an opportunity to prove his charges, and since the lower courts necessarily assumed that the facts were as alleged, the basis for the petition fails.

POINT III.

Petitioner seeks contravention of the statute limiting the patent term to seventeen years.

The amended complaint seeks relief *for infringement* from the time that plaintiff's patents "would have issued" but for the defendants' alleged wrongful acts. In short, it calls upon this Court to contravene the Statute (R. S. Sec. 4884; U. S. C. Title 35, Sec. 40), limiting

the patent term to seventeen years by giving plaintiff's patents an indefinite term in excess of the statutory period. Only Congress can extend the statutory patent term.

The only relevant question, therefore, which is raised by the pleadings is whether a patentee can sue for "infringement" based upon acts allegedly committed prior to the issuance of his patent. No authority is cited for any such radical remedy.

Even if petitioner were allowed to prove and did prove the alleged fraud, it would still not give the Court the power to grant the relief prayed for, namely, damages for patent "infringement" prior to the issuance of the patents. *Stark Brothers* v. *Stark*, 255 U. S. 50. There this Court said:

> "The plaintiff argues that a notice * * * coupled with the wilful character of the defendants' wrongdoing ought to lead to a different result [*i. e.*, an award of an accounting over a period prior to the date of notice of registration of plaintiff's trade mark], and the District Judge seems to have had a similar notion. But that is to forget the origin and necessary limit of the jurisdiction in this case."

POINT IV.

No Reviewable Question Is Presented by the Petition.

We respectfully call attention to the following as showing that the petition presents no proper ground for granting the writ:

1. Petitioner asks (p. 6) that this Court recognize the necessity "for so emphasizing or restating the *Hurn*

v. *Oursler* doctrine'' that it will be applied uniformly in all jurisdictions. This is an admission that the petition presents no new or controversial question for review. Petitioner also asks whether the Court can determine the question of jurisdiction of its claim before trial. The answer is obviously that it can.

2. Whatever the merits of petitioner's contention that *Hurn* v. *Oursler* has been differently construed in different circuits, petitioner has not shown that it has been differently applied to the same state of facts or differently construed on any point which is relevant here. So far as the petition and supporting brief show, there has been no conflict of decisions on any question presented by petitioner.

3. The petition in effect seeks a review of Judge Bondy's order dismissing the second cause of action for lack of diversity. This order was held by the Circuit Court of Appeals not to be appealable (especially, we submit, after petitioner's acceptance of Judge Bondy's decision by filing an amended complaint), and we believe that it is not a matter for review by this Court. Judge Caffey's order striking irrelevant matter is likewise not reviewable here.

Petitioner shows that the *Oursler* doctrine has been applied to different states of facts not involved here and has failed to show any conflicting decisions on the same facts as presented here.

Petitioner's questions on pages 3 and 4 are presented on the assumption that the alleged wrongful misuse of interference proceedings is not a Federal matter in the absence of diversity, and are briefly answered as follows, the numbering corresponding to the questions:

1. As pointed out below, *Hurn* v. *Oursler* sanctions dismissal of a non-federal claim (in the absence of

diversity) before trial and on the pleadings only. The examples, in the opinion of the Circuit Court of Appeals, of proof that would go beyond the Federal claim were not "suppositions" but are alleged in the amended complaint (R. 72).

2. The Court made no assumption other than that the allegations of the pleadings are correct, and declared it to be a fact that the proof for the alleged two causes could not possibly be made on substantially identical facts.

3. In order to show jurisdiction of the non-federal claim, plaintiff must set forth sufficient facts to show that the same facts support the charges of statutory infringement and his non-federal claim. Even the petition fails to state unequivocally that the same *facts* support both alleged causes of action.

4. It is not evident from the pleadings nor from anything that petitioner asserts, nor does plain reason reveal, how the Patent Office interference record is admissible to establish patent infringement. Petitioner's premise is based on the false idea that there can be patent "infringement" for acts committed prior to the grant of the patent.

5. All the evidentiary facts bearing on jurisdiction were before the Court in the pleadings and petitioner offers no new facts. Dismissal for lack of jurisdiction before trial is, of course, common practice.

6. This question was answered emphatically in the negative by the opinion of the Circuit Court of Appeals. The statutes in question are too explicit and the practice under them too well established to necessitate their review.

The Court may well wonder what support petitioner has for his assertion (p. 3) that at the trial "he can prove the entire cause of action, including both claims for relief, with only the facts necessary to establish the patent infringement claim".

Statutory infringement of a patent can occur only after its issuance. The decision whose review the petitioner seeks affirms this established principle. The facts establishing the alleged delay in the issuance of petitioner's patents obviously could have occurred only prior to the issuance of the patents.

It is significant that the petitioner makes no effort to explain how "both claims for relief" are supported by the same facts. The reason is that there is an element of deceit in petitioner's position. When petitioner speaks of "the patent infringement claim" he has tongue in cheek, and conceals his mental reservation that by his private definition this term embraces not only the claim for statutory infringement after issuance of the patent, but also his mythical "constructive infringement" which, he urged before the Court of Appeals, covered a period prior to the issuance of his patents. Obviously, if petitioner openly coupled his claim for damages for respondents' alleged wrongful acts with this "constructive infringement", the falsity of his position would be apparent, for there have never been two schools of thought on the right to sue for infringement prior to issuance. Yet this discredited notion of "constructive infringement", discussed in the opinion of the Court of Appeals (R. 108, 109), is latent in all of petitioner's questions and arguments.

The above will make clear the parenthetical remark on page 4, paragraph 4 of the petition that the evidence admissible on the patent infringement claim includes "the interference record". This record is relied on to establish both the "infringement" prior to issue, and the al-

leged wrongful delay. But petitioner is careful to avoid saying so openly.

Petitioner treats the interference record as if it were itself the fact which supports his illusory causes of action. Even if the interference record contained facts usable in an effort to establish the alleged common law wrong, and even if the same facts were usable to prove the mythical "constructive infringement" prior to the issuance of the patents, it is inconceivable how any of the facts in the interference record could be usable to prove statutory infringement which could begin only after the issuance of the patents. Until petitioner has presented authority for "infringement" prior to the issuance of a patent, it follows that there can be no facts in the interference record or elsewhere which could simultaneously establish the alleged common law wrong and statutory infringement.

From one aspect the petition seems to seek only a ruling on the admissibility of evidence. In effect, petitioner wants this Court to instruct the District Court to admit the interference testimony in support of his claim for patent infringement. The petition presents no reason why this question should be reviewed by this Court.

The admissibility of evidence bearing on the conduct of a defendant before the Patent Office was considered and denied in *Automatic Arc Welding Co.* v. *General Electric Co.*, 2 F. S. 908, 909 (D. C. S. D. N. Y.), wherein the Court said:

> "The complaint, in addition to charging infringement, contains allegations that the defendant harassed and delayed Morton in the Patent Office proceedings, and testimony was offered at the trial in support of these allegeations, subject to motions to strike. These motions are now before me for disposition, and I think they should be granted,

inasmuch as the testimony has no logical bearing on the issues of validity and infringement involved in the suit."

POINT V.

Petition fails to show how the alleged two claims can be based on the same set of facts.

It will be noted that the complaint neither alleges nor does the petition assert that the same set of facts supports both asserted causes of action. Petitioner merely complains that the courts below assumed that such would not be the case. He makes no attempt to show how the facts can possibly be the same. He makes vague reference to "the interference record" but that can be relevant only to the question of priority, which is not an issue in this case.

Hurn v. *Oursler* holds that to justify federal jurisdiction over the non-federal cause of action, the federal and non-federal causes of action must be based upon "the same facts". This Court there stated (p. 246):

> "Indeed, the claim of infringement and unfair competition so precisely rest upon identical facts as to be little more than the equivalent of different epithets to characterize the same group of circumstances."

Petitioner appreciates that his case stands or falls upon the issue of the identity of the facts supporting his charge of infringement and his charge of fraud. He asserts repeatedly that the facts are the same, thereby giving lip service to the requirement laid down by *Hurn* v. *Oursler,* but he makes no effort to show that they are the same. His amended complaint does not allege such identity, and his original complaint emphasized their non-

identity by expressly admitting that the alleged fraud occurred during the pendency of his patent applications and so before any statutory infringement could possibly have occurred.

Instead of showing such identity of facts, petitioner introduces a red herring in the form of an alleged conflict in the interpretation of *Hurn* v. *Oursler*. But whatever the situation may be on issues not relevant here, it is clear that there is no conflict with respect to the rule of identity of facts laid down by that decision. The very cases relied on by petitioner show this clearly enough. Thus in *E. Edelmann* v. *Triple-A Specialty Co.*, 88 F. (2) 852, 854 (cert. den. 57 Sup. Ct. 673), the Court made specific reference to the appellee's contention that it was "entitled to damages for violation of its common-law rights arising out of the same facts". The action was for declaratory judgment "averring that appellant had wrongfully charged appellee with infringement * * * and had notified the trade of such untrue charges" and demanding, among other things, that appellant be enjoined "from publication of such charges". It is obvious that in this case the same acts constituted both the charges of infringement broadcast to the trade, and the unfair competition, and so the Court, despite the absence of diversity, properly assumed jurisdiction of both aspects of the "same group of circumstances".

In the decision in *Atkins* v. *Gordon*, 86 F. (2) 595, no facts are stated with respect to the unfair trade method charges. Denial of jurisdiction was proper if the "unfair trade method" involved facts other than the *manufacture* or *use* or *sale* of the alleged infringing article, as it most likely did.

Hemmeter Cigar Co. v. *Congress Cigar Co.*, 118 F. (2) 64, in the extract quoted by petitioner (p. 10) again emphasizes that "both claims [are] based on the same acts", citing *Hurn* v. *Oursler*.

Petitioner has failed to show conflict in decisions involving application of the doctrine of *Hurn* v. *Oursler* to an action involving a claim for patent infringement and alleged fraud which could have occurred at no other time than prior to the issuance of the patent and did not and could not involve manufacture, use or sale of a patented article.

POINT VI.

This court has previously denied certiorari on grounds raised by petitioner.

Petitioner's statement (p. 6), that this is "the first case brought to this court where an attempt has been made to apply the *Hurn* v. *Oursler* doctrine before trial" is not true, and this is borne out, for instance, by the *Musher Foundation, Inc.* v. *Alba Trading Co., Inc.* case cited by petitioner (p. 5). In that case, the District Court for the Southern District of New York dismissed a second cause of action, on motion by defendant, on the ground that the Court lacked jurisdiction in the absence of diversity of citizenship, and on appeal, the Circuit Court of Appeals affirmed. Certiorari was denied by this Court (317 U. S. 641).

The *Musher* case is extremely pertinent because exactly the same issue was raised therein on petition for writ of certiorari as is raised by the present petition. On page 3, the Musher petition said:

> "This ruling of Judge Clancy dismissing the second cause of action upon the ground that the Court lacked jurisdiction in the absence of diversity of citizenship was contrary to the ruling of this Court in *Hurn* v. *Oursler,* 289 U. S. 238, and is also contrary to other interpretations of this decision

by other judges in the United States District Court for the Southern District of New York and other United States District Courts in other parts of the country."

On page 4, the petition stated:

> "Therefore, this petition presents an important question of wide and general interest involving the proper interpretation of this Court's decision in *Hurn* v. *Oursler,* 289 U. S. 238."

The Musher petition also maintained that the same acts established infringement of the patents in suit and likewise unfair competition. The petition went on to say (p. 5):

> "The opinion of the Circuit Court of Appeals for the Second Circuit in this case (127 F. [2d] 9) shows an irreconcilable conflict not only between the majority and the minority of the judges who dissented but as to other decisions and opinions both of the Circuit Court of Appeals for the Second Circuit (see also *Treasure Imports, Inc.* v. *Amdur, et al.,* 127 F. [2d] 3, and *Pure Oil Co.* v. *Puritan,* 127 F. [2d] 6) and other courts as to the proper interpretation of the Supreme Court's decision in *Hurn* v. *Oursler,* 289 U. S. 238.
>
> The opinion of the Circuit Court of Appeals which has already been reported at 127 F. (2d) 9 fully sets forth this conflict in the majority and minority opinions * * *."

In fact, *Hurn* v. *Oursler* itself sanctions dismissal before trial for want of jurisdiction in the following words:

> "Two * * * Since that claim did not rest upon any federal ground and was wholly independent of the claim of copyright infringement, the district court was clearly right in dismissing it for want of jurisdiction * * *. From these averments two separate and distinct causes of action resulted, one arising under a law of the United States, and the other arising under general law. For reasons that have already been made manifest, the latter is entirely outside the federal jurisdiction and subject to dismissal *at any stage of the case.*" (Italics added.)

The present case is even less favorable to the petitioner than were those cited above. There is a reasonable possibility that the same acts will support both infringement and unfair competition; it is an impossibility for acts committed after issuance of a patent simultaneously to constitute the basis of a wrong which could have been committed only prior to such issuance.

CONCLUSION.

Accordingly, it is believed that the petition for writ of certiorari should be denied.

Respectfully submitted,

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